

DOCKET: 915-008.034
USSN: 10/533,245

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of: Peter Dam Nielsen et al. Confirmation No.: 5173
Serial No.: 10/533,245 Art Unit: 2617
Filed: April 29, 2005 Examiner: Dai Phuong
Docket Number: 915-008.034

For: COMMUNICATION APPARATUS AND A METHOD OF INDICATING
RECEIPT OF AN ELECTRONIC MESSAGE, AND A SERVER, A METHOD
AND A COMPUTER PROGRAM PRODUCT FOR PROVIDING A
COMPUTERIZED ICON ORDERING SERVICE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW
ACCOMPANIED BY NOTICE OF APPEAL

Sir:

In response to the Final Action of June 22, 2010, Applicant requests review
of the rejection prior to preparing an Appeal Brief for the following reasons:

REMARKS

In summary, the present invention claims a communication apparatus comprising a controller (800), an interface (806-850) configured to receive an electronic message (852); a display (836); and a memory (802; 804). The memory is configured to store *inter alia* at least one predefined icon for presentation on the display so as to indicate receipt of the electronic message. The memory (802-804) is configured to store an association (844, 846) between the at least one predefined icon (846) and a telephone number. The controller (800) is configured to extract the telephone number in the received electronic message, match it to a stored telephone number, and to present a matching icon, if any, on the display to indicate receipt of said received electronic message wherein the displayed matching icon is for use by a user of the apparatus to identify a sender of the electronic message according to the identification of the person stored with the telephone number, wherein the identification is not displayed with the icon. With this approach, an icon with an association to a particular sender will be displayed and indicate to the user who the sender is without unduly jeopardizing the sender's integrity or privacy because of the name and identity (such as a telephone number) of the sender are not shown on the display. See the specification at page 5, lines 8-13 corresponding to published paragraph [0014] on page 2 of US 2006/0084450. In other words, persons nearby cannot identify the sender because only the user knows the association.

The Examiner admits that the *Kamimura* reference (US 2002/0094806) does not disclose that the identification is not displayed with the icon. Rather, *Kamimura* does everything possible to put as much information about the sender on the display as possible. This would jeopardize the sender's privacy.

To negate this difference in the *Kamamura* document (that takes a completely contrary approach), and explicitly reciting applicants' own concern to prevent exposure of the sender as the motivation of one of ordinary skill to make a modification, the Examiner cites *Sim et al* (US 6,771,974). The *Sim et al* disclosure has to do with making a change to the conventional short message service (SMS) text messaging function that only provides one-way transmission of the short

message. This is viewed as disadvantageous by *Sim et al* because the message is held in a SMS server until the intended receiver is ready to get it which may be some time later. However, if the sender and receiver would rather operate in real time, the conventional SMS function does provide for two-way transmission of short messages and the sender and receiver cannot exchange short messages with each other in real time as in two-way voice communications. *Sim et al* set out to modify the SMS architecture to allow that.

The *Sim et al* reference does not at all deal with what kind of information is shown to the receiver about the identity of the sender, which of course has to take place in order to establish a communication channel in the first place. What *Sim et al* deals with is how the real-time aspects of the modification they propose to the conventional SMS function would operate.

The functionality shown in Fig. 4, to which the Examiner points, has to do with after the real-time session has already been established and therefore any screen images that might have been displayed prior to this real-time exchange of messages is not even discussed at all except implicitly, in a very general way in the flowchart of Fig. 2, where it indicates for instance at step 212 that a two-way dialogue has been selected after entering SMS mode in a step 210.

Therefore, it has to be understood that the passage cited by the Examiner at column 3, lines 52-55 has to do with how to split the screen to show both sides of the communication to both participants after the setup has already been carried out. Obviously, during the setup, there would have to be some indication on the screen of the identity of the sender as adverted to by *Sim et al* in line 55. What *Sim* is therefore showing by implication is that after the identity of the sender has been identified on the screen, it is not displayed anymore after the real-time communication commences because the receiver already knows with whom he is communicating by virtue of entering the SMS mode in the first place. In carrying out these activities it is plainly the case that *Sim et al* do not have any concern about how the identity of the sender is displayed much less preventing exposure of the sender's identity, nor is there even any hint of that.

The Applicants gave a detailed and carefully reasoned explanation of this situation in the Remarks Section of the Request for Reconsideration filed April 5, 2010 where it was also argued that the combination proposed by the Examiner of not showing identification as in the split screen of Fig. 4 of *Sim et al* is erroneous since it does not deal with identification and therefore does not hint at or suggest prevention of exposure of identity of a person to a third party and would not suggest to one of ordinary skill in the art to make a modification to the methodology shown by *Kamimura*. In the Final Rejection, the Examiner has repeated the alleged motivation to be in order to prevent the exposure of the identification of a person to a third party. But the Examiner does not explain where this motivation comes from other than the Applicants' own disclosure by way of hindsight. See lines 1 and 2 on page 7 of the Detailed Action in the Final Action of June 22, 2010. To the contrary, *Kamimura* is intent on supplying a surfeit of information (see *Kamimura*'s Figs. 2, 9 and 11) because of the difficulties mentioned in paragraphs [0006] and [0007] on page 1 and the modified SMS architecture of *Sim et al* would not give any hint or suggestion to change that.

In the "Response to Argument" Section beginning of page 2 of the Detailed Action of June 22, 2010, the Examiner merely states that it is obvious that the receiving message includes the identification of the sender of the message, without displaying the identification of the sender of the message. The reasoning in this line of argumentation is not understandable or is missing. Therefore, the obviousness rejection based on the combination of *Kamimura* and *Sim et al* is clearly erroneous because it is not based on a correct factual foundation and the analysis is faulty.

The rejections of the other independent claims are similar and are erroneous for the same reasons. The rejections of the dependent claims are erroneous for at least the same reasons.

Reconsideration and allowance is requested.

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Respectfully submitted,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 915-008.034					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/533,245	Filed April 29, 2010					
	First Named Inventor Peter Dam Nielsen et al.						
	Art Unit 2617	Examiner Dai Phuong					
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,391</u></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px; text-align: right;">/Francis J. Maguire/ _____ Signature Francis J. Maguire _____ Typed or printed name 203-261-1234 _____ Telephone number December 21, 2010 _____ Date</td></tr><tr><td style="vertical-align: top; padding-bottom: 10px;"><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>31,391</u>	/Francis J. Maguire/ _____ Signature Francis J. Maguire _____ Typed or printed name 203-261-1234 _____ Telephone number December 21, 2010 _____ Date	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	
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